

REMARKS

Formal Matters

Claims 1-33 are pending and have been examined. Claims 1-27 have been rejected. Objections have been made as to claims 28-33. Claims 1 and 15 are amended to clarify their nature; no change in scope is intended or should be inferred. No new matter is added.

35 U.S.C. §112

Claims 28 and 29 are rejected as “omnibus type” claims. Applicant asserts that they are not. Instead, they are proper claims relying on the drawings as is permissible under *In re Foust* 86 USPQ 114 (1943) – copy attached. If the Examiner is to persist in regarding the claims otherwise, some authority should be cited and explanation provided in support of the position. *See* 35 U.S.C. §132.

Still, Applicants note a willingness to cancel (without prejudice) claims 28 and 29 should claims 1-27 be deemed allowable in view of this Amendment. If the Examiner is so-inclined, a call placed to the undersigned will expedite matters in this regard.

37 C.F.R. 1.75(c)

Claims 30-33 were objected to as being improper as dependent from a multiple dependent claim. Applicant asserts that there are in fact no multiple dependent claims in the present application. For example, claims 30, 32 and 33 are independent claims. They merely make reference to claim 1-29 in a Markush-type group. Should the Examiner persist in regarding any of the claims as multiple dependent, Applicant may choose to expressly set forth the referenced subject matter word for word. Of course, that would dramatically expand the length of the claims. Accordingly, it is requested that the Examiner withdraw the rejection.

Common Ownership

Applicants note that any invention presented in the subject specification was subject to assignment obligations to the Agilent Technologies, Inc. prior to their conception or reduction to practice.

35 U.S.C. §103

Regarding Noblett, the Examiner is correct in characterizing the system as using a series of scans where features are irradiated and iterative adjustment of the sensitivity of the system is undertaken to find the optimal setting for a given sample and fluorophore. More particularly, specific dilution mark features as scanned to perform the calibration process.

However, no such iterative process is undertaken in Noblett regarding the “sample” applied to the array. An example of what Applicants mean by “sample” it is stated in ¶0053:

The subject arrays find use in a variety applications, where such applications are generally analyte detection applications in which the presence of a particular analyte in a given **sample** may be detected qualitatively or quantitatively. Protocols for carrying out such assays are well known to those of skill in the art and need not be described in great detail here. Generally, the **sample** suspected of comprising the analyte of interest is contacted with an array produced according to the subject methods under conditions sufficient for the analyte to bind to its respective binding pair member that is present on the array. Thus, if the analyte of interest is present in the sample, it binds to the array at the site of its complementary binding member and a complex is formed on the array surface.

The “sample” relevant to the claims is that which contains the compound of ultimate interest in performing the assay for which the array is scanned.

In contrast, the calibration process in Noblett does not involve iteratively scanning anything other than its dilution spots 119a-119g - each having different fluorophore concentration. As stated in Noblett,

Prior to imaging the hybridized spots 112, the microarray scanning system 10 images the dilution spots 119 while adjusting ... [scanner settings] The sensitivity of the microarray scanning system 10 can thus be optimized without the risk of photobleaching of the hybridized spots 114 and 118 of the microarrays 111 and 115.” Col 7: lns. 10-23.

It is these hybridized spots (which are not the subject of repeated scanning) that have been acted upon the relevant “sample” as should be understood in the context of the claims.

Accordingly, the Noblett system does not in fact “perform a first automated scan of said array to detect said sample, wherein at least some results of said sample scan are saturated to obtain a first set of non-saturated results” as required of claim 1. (Emphasis added.) It only performs automated scans on calibration features. Not the features providing sample results pertinent to a given experiment or assay.

Furthermore, Noblett does not disclose performing a first automated scan of an array to detect **sample**, determining if any from that first sample scan are saturated, and terminating scanning if no

results are saturated, or performing a second automated scan at a decreased sensitivity from the first scan if any results are saturated - as required by claim 15.

In fact, the Noblett system is not configured to make any decision to rescan or not in view of whether results of scanned sample are saturated. The Noblett system is not even configured to make a determination of whether results of scanned sample are saturated *in the first place*. Such activity is enabled only in connection with the dilution spots – not the hybridized spots corresponding to “sample” as set forth in Applicants’ claims.

For the above reasons, claims 1, 15 and those dependent therefrom are believed to be in condition for allowance. Yet, should the Examiner decide to persist in maintaining the rejection, it is respectfully requested that she very carefully explain how the dilution spots in Noblett might be regarded as “sample” to the extent Applicants’ claims require.

In any case, Applicants’ make no acquiescence to the remainder of the Examiner’s points of rejection because they are believed moot in view of the foregoing. As such the present Amendment is fully responsive and Applicants reserve the right to make further comment as might be necessary.

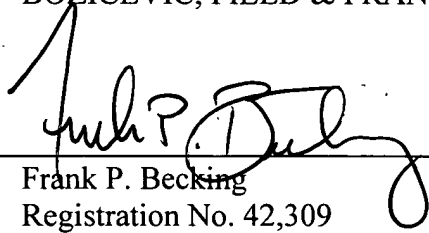
Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10011208-1.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: 1/8/09

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